

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed September 29, 2004 (the "Office Action"). In the Office Action, Claims 1-81 are pending in the application and the Examiner rejects to Claims 1-81. Applicant notes with appreciation the Examiner's acceptance of the drawings filed on April 23, 2001. Applicant amends Claims 39 to correct a typographical error. Applicant respectfully requests reconsideration and allowance of all pending claims.

### **Claim Objections**

The Examiner objects to Claims 39-72, 77, and 79 because of an extraneous period in Claim 39, line 17. Applicant amends Claim 39 accordingly.

### **Double Patenting Rejections**

The Examiner rejects Claims 1-81 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-100 of U.S. Patent No. 6,621,632 B2 issued to Zhou ("*Zhou*"). A "nonstatutory-type" double patenting rejection is "based on a judicially created doctrine grounded in public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinguishing from claims in a first patent." In this regard, the "doctrine of double-patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent." MPEP § 804. Applicants respectfully submit that the claims of the pending application are indeed patentably distinguishable from the claims of *Zhou* and, therefore, would not unjustifiably extend the term of *Zhou*.

For example, Claim 1 of the pending application recites, in part, a "tunable optical element operable to ... receive **a first input signal**" and "**a second input signal**" and a "reflective element ... to produce **an output signal**, wherein the output signal comprises wavelength channels of the first input signal combined with wavelength channels of the second input signal." (Emphasis added). Claim 1 of *Zhou*, on the other hand, recites, "a tunable optical element operable to receive **an input signal** ... and a reflective element operable to ... produce **a first output signal** and **a second output signal**, the first output signal comprising a first subset of wavelength channels from the input signal and the second output signal comprising a second subset of wavelength channels from the input signal."

(Emphasis added). Therefore, whereas the claims of the pending application are directed to a “multiplexing” operation, the claims of *Zhou* are directed to a “demultiplexing” operation. Moreover, the claims of the pending application are also patentably distinguishable from Claim 15 of *Zhou*, to which the Examiner refers on page 3 of the Office Action. Claim 15 of *Zhou* depends from Claim 14 and, together, those claims are directed to further “demultiplexing” operations. One of skill in the art recognizes that a “demultiplexing” operation is fundamentally distinct, and therefore patentably distinguishable, from a “multiplexing” operation. As a result, the issuance of the claims in the pending application would provide no “unjustified extension of patent exclusivity” beyond the term of *Zhou*. The two sets of claims are simply directed at two different operations. For at least these reasons, Applicant respectfully requests the Examiner to remove the double patenting rejection and allow all pending Claims.

**CONCLUSION**

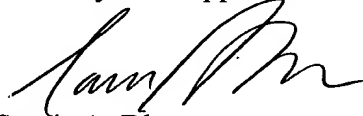
Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If there are matters that can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the undersigned attorney at (214) 953-6581 at the Examiner's convenience.

Although Applicant believes that no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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